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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,006	01/15/2002	Chien-Jung Chen	CHEN3316/EM	2717

7590 01/27/2005
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EXAMINER
ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,006

Applicant(s)

CHEN ET AL.

Examiner

Boyer D. Ashley

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3724

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, Subgroup X, and Species I in the reply filed on 11/26/03 and 3/11/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 8-9 and 11-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/26/03 and 3/11/04.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings are objected to because the sign "412" on page 7, line 24 is missing from the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

Art Unit: 3724

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: on page 1, line 17, the sign "06" should be "96". Appropriate correction is required.

Claim Objections

6. Claim 5 is objected to because of the following informalities: line 3 includes a period in the middle of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3724

In claims 1 and 2, the expressions "may be", "may detect", and "may send a signal" language, e.g., in the phrase "... at least two rolls that may be driven by..." is confusing, in that, it is not clear whether or not the least two rolls are driven.

In claim 2, the expression "a power member" on lines 8 and 9 is confusing, in that, it is not clear if they are the same power member or not. the phrases "... two ends respectively pivoted between the two wall plates ..." is confusing, in that, it is not clear how the rollers pivoted. Shouldn't this be "... two ends respectively rotated between the two wall plates ..."?

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagel et al., U.S. Patent 4,284,221.

Nagel et al. discloses the same invention as claimed including, e.g., a separation device having: two sets of rolls (5/6 and 7/8) with at least two rolls each positioned between two walls of a frame (see Figure 4), wherein the rolls are driven by a power member (12) at equal speeds (see the abstract). A detection member (16/17) is located between the two sets of rolls for detecting perforations (3) on the web (1a) and sending a signal for increasing the speed of the second set of rolls or decreasing the speed of the first set of rolls such that the web is separated.

Art Unit: 3724

It should be noted that references of the specific workpiece and any attempt to define the invention in terms of the workpiece do not serve to distinguish the claimed invention over the prior art. See MPEP 2114.

As to claim 4, Nagel et al. discloses the use of clutch wheel (column 4, line 5-25).

As to claim 5, the rolls of each set of Nagel et al. are in contact with each other. The phrase "... has a length smaller than that of an elongated hole of the paper towel" as stated above does not serve to distinguish the claimed invention from the prior art because it is in terms of the workpiece.

As to claim 10, although Nagel et al. discloses a workpiece with a sensing mark that is easily detachable, it should be noted that this claim is also in terms of the workpiece and does not serve to distinguish the claimed invention from the prior art.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel et al., U.S. Patent 4,284,221, in view of Gergek, US Patent Application 2002/0033405.

Nagel et al. discloses the invention substantially as claimed except for one set of the rolls forming a non-single line contact between the rollers, wherein the rollers have convex portions; however, Gergek discloses that it is old and well known in the art to

Art Unit: 3724

use convex roller portions in a burster for the purpose of facilitating the movement of the separated piece. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use convex roller portions with the roller of Nagel et al. in order to facilitate the movement of the separated piece.

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art references are cited to show similar devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
January 21, 2005